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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CARDONE, JASON D

ART UNIT PAPER NUMBER

2145

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,833

Applicant(s)

BRETCHER, JOHN T.

Examiner

Jason D. Cardone

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date, _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/12/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 27, 28, 33, 34-42 and 48-91 are objected to and rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
2. Claims 27 and 28 disclose a real-time game application being selected and used in the embodiment disclosed in claim 16. The specification does disclose game applications [Spec, col. 11, lines 35-39] but does not disclose how one of ordinary skill in the art, at the time the invention was made, to incorporate the game application into the embodiment of claim 16.
3. Claims 33 and 34-42 disclose that a communication path does not “pass through” the front-end server. The drawings are relied upon to disclose the written description of the path not passing through the front-end server but does not disclose how one of ordinary skill in the art, at the time the invention was made, to be enabled to have a communication path does not “pass through” the front-end server.
4. Claim 38 discloses a real-time game application being selected and used in the embodiment disclosed in claim 34. The specification does disclose game applications

Art Unit: 2145

[Spec, col. 11, lines 35-39] but does not disclose how one of ordinary skill in the art, at the time the invention was made, to incorporate the game application into the embodiment of claim 34.

5. Claims 48-55 and 70-77 disclose "connecting two users via the Internet and via the front-end server to initiate communication with the dedicated processor". The specification does disclose two users [Spec, col. 10, line 39 and col. 11, line 4] but does not disclose how one of ordinary skill in the art, at the time the invention was made, to be enabled to have connected two users via the Internet and via the front-end server to initiate communication with the dedicated processor within the embodiments of the invention.

6. Claims 56-65, 68, 69, 78-87, 90 and 91 disclose cellular telephone communication. The specification does disclose cellular [Spec, col. 10, line 38] but does not disclose how one of ordinary skill in the art, at the time the invention was made, to be enabled to have cellular telephone communications within the embodiments of the invention.

7. Claims 64-67 and 86-89 disclose a real-time game application being selected and used in their respective embodiments of the invention. The specification does disclose game applications [Spec, col. 11, lines 35-39] but does not disclose how one of

Art Unit: 2145

ordinary skill in the art, at the time the invention was made, to incorporate the game application into the embodiments of the claimed invention.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claim 43 is objected to and rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 43 recites the limitation "one of the selected dedicated processors". There is insufficient antecedent basis for this limitation in the claim for multiple processors.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January

Art Unit: 2145

1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-47 are rejected on the ground of nonstatutory obviousness-type double patenting. Claims 1-15 of USPN 6,370,564 and claims 1-13 of USPN 6,175,854 contain every element of claims 1-47 of the instant application and as such anticipate claims 1-47 of the instant application. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " **ELI LILLY AND COMPANY v BARR LABORATORIES, INC.**, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

Art Unit: 2145

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 48-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Freeman et al. ("Freeman"), USPN 5,428,608.

14. Regarding claim 48, Freeman discloses a method for using a computer system in processing an application, the method including the steps of: providing a front end server, providing a plurality of dedicated processors so that the front end server can communicate with at least one of the plurality of dedicated processors [Freeman, col. 5, lines 17-40],

connecting two users via the Internet and via the front-end server to initiate communication with the dedicated processor, and executing a real-time application program on the dedicated processor to enable the users to communicate voice with each other [Freeman, col. 3, lines 3-36 and col. 11, line 34 – col. 12, line 51].

15. Regarding claims 49 and 50, Freeman further discloses facilitating a teleconference/voice conference with another user [Freeman, col. 11, lines 34-51].

16. Regarding claims 51-53, Freeman further discloses connecting one of the users to an existing voice conference and enabling manipulation/movement of a parameter of the voice conference [Freeman, col. 11, lines 34-65].

Art Unit: 2145

17. Regarding claims 54 and 55, Freeman further discloses sending the user's voice stream via a telephone network and sending data with the voice [Freeman, col. 11, lines 34-65].

18. Regarding claims 56-91, claims 56-91 have similar limitations as claims 48-55 with the addition of a game application. Therefore, the similar limitations are disclosed under Freeman for the same reasons set forth in the rejection of claims 48-55 [Supra 48-55]. In addition, Freeman discloses a game application [Freeman, col. 3, lines 3-36].


Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone whose telephone number is (571) 272-3933. The examiner can normally be reached on Mon.-Thu. (6AM-3PM).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2145

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone
SPE
Art Unit 2145

December 9, 2005